

*REMARKS*

*Pending Claims*

Currently pending claims are claims 1, 5-6, 9-18, 20-33. Claims 1, 9-13 and 31 have been amended. Claims 32 and 33 are new.

*Specification Amendments*

Applicant has amended paragraphs [0004] and [0034] to correct a typographical error for the word “vice” to “vise”.

*Summary of Telephone Interview*

Applicant wishes to thank Examiner John T. Kavanaugh for his time and effort during a telephonic interview with Applicant’s attorney, John Augustyn, on July 21, 2004. During the interview possible amendments to the claims were discussed which are included in this Response. In addition, the following references were discussed: Terlizzi U.S. 5,682,685; Morrone U.S. 2002/0078591; Terlizzi U.S. 4,453,996; and Minden U.S. 5,035,069, which were discussed as noted in this Response.

*Summary of the Office Action*

The Office Action rejected claims 1-4, 19-22, 23, 30 and 31 under 35 U.S.C. § 102(b) as being anticipated by U.S. 5,682,685 to Terlizzi. In addition, claims 1-5, 14-16, 19, 23, 30, 31 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. 2002/0078591 to Morrone. Also, claims 1-31 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. 4,453,996 to Terlizzi et al. in view of U.S. 5,682,685 to Terlizzi. Further, claims 1-6, 8-26, 28-31 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. 5,035,069 to Minden in view of U.S. 5,682,685 to Terlizzi.

Applicant respectfully submits that pending claims 1-33 are patentable over the prior art cited. With respect to the rejection in view of U.S. 5,682,685 to Terlizzi (“Terlizzi ‘685 patent”), the Terlizzi ‘685 patent does not disclose the use of a shank. In fact, the Terlizzi patent teaches away from using a shank. The Terlizzi ‘685 patent states “use of the invention avoids the need for a shank, that is, a substantially flat plate that extends rearwardly from the toe box toward the arch beneath the foot is unnecessary”. (Col. 4, lines 58-61). In addition, the front sole in the Terlizzi ‘685 patent appears to be made of a plastic material since it appears to be a molded sole. Thus, independent claims 1, 31, 32 and 33 are patentable over Terlizzi U.S. 5,682,685 because these claims include, inter alia, a shank and furthermore independent claims 32 and 33 include, inter alia, a front sole and rear sole made of leather.

With respect to the rejection in view of U.S. 2002/00778591 to Morrone, ("Morrone '591"), the Morrone '591 does not disclose a shank. In addition, the Morrone '591 appears to show a front sole portion 20 and a rear sole portion 40 which appear to be molded. (See Figs. 2 and 3). Thus, independent claims 1, 31, 32 and 33 are patentable over Morrone because these claims include, inter alia, a shank and furthermore independent claims 32 and 33 include, inter alia, a front sole and rear sole made of leather.

The rejections under 35 U.S.C. § 103 for obviousness are not proper. To reject a claim as obvious over a combination of the prior art references, there must exist some suggestion or motivation, either in the prior art itself or in the knowledge of one of ordinary skill in the art, to combine the references as provided. See, e.g., M.P.E.P. § 2143. The mere fact that the prior art references can so be combined, absent a motivation to do so, is insufficient. See, e.g., *id.* Moreover, it is improper to employ hindsight gleaned from the Applicant's invention to support an obviousness rejection.

With respect to the rejection under 35 U.S.C. § 103 in view of U.S. 4,453,996 to Terlizzi et al. ("Terlizzi '996 patent") and U.S. 5,682,685 to Terlizzi, the pending claims are patentable over this combination. The Terlizzi '996 patent does not disclose a split sole shoe. In the Terlizzi '996 patent, the sole 22 extends along the length of the shoe. The pending claims include, inter alia, a front sole and a rear sole. With respect to the Terlizzi '685 patent, the Terlizzi '685 patent does not include a shank and teaches away from the use of a shank as noted above. The pending claims include, inter alia, a shank. There is no suggestion or motivation in either of the references to combine the references as noted in the Office Action. Therefore, the pending claims are patentable.

With respect to the rejection under 35 U.S.C. § 103 in view of U.S. 5,035,069 to Minden ("Minden '069 patent") and U.S. 5,682,685 to Terlizzi, the pending claims are patentable over this combination. The Minden '069 patent does not disclose a split sole. The pending claims include, inter alia, a front sole and a rear sole. With respect to the Terlizzi '685 patent, the Terlizzi '685 patent does not have a shank and teaches away from the use of a shank as noted above. There is no suggestion or motivation to combine these references. As noted above, the pending claims include, inter alia, a front sole, a rear sole and shank. Therefore, the pending claims are patentable.

### *Conclusion*

The application is considered in good and proper form for allowance, and the Examiner is respectfully requested to pass this application to issue. If, in the opinion of the

In re Appln. of BARUCK  
Application No. 10/033,987

Examiner, a telephone conference would expedite the prosecution of the subject application,  
the Examiner is invited to call the undersigned attorney.

Respectfully submitted,



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